



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,520	07/23/2003	Makoto Ishii	030179	1367
23850	7590	06/29/2004	EXAMINER	
ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP 1725 K STREET, NW SUITE 1000 WASHINGTON, DC 20006			BELL, KENT L	
			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/624,520		ISHII ET AL.	
	Examiner		Art Unit	
	Kent L. Bell		1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- application filed 7/23/03*
- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner. (*Fig. 9A and 9B*)
- 10) ☒ The drawing(s) filed on 7/23/03 is/are: a) ☒ accepted or b) ☒ objected to by the Examiner. (*Fig. 1 through 8B*)
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

K. L. Bell

Detailed Action

Objection to the Drawing

The following is a quotation of section (a) of 37 CFR 1.165:

(a) Plant patent drawings are not mechanical drawings and should be artistically and competently executed. Figure numbers and reference characters need not be employed unless required by the Examiner. The drawing must disclose all the distinctive characteristics of the plant capable of visual reproduction.

The submitted photographic illustrations (Fig. 1 through Fig. 8B) filed July 23, 2003 are objected to under 35 CFR 1.165(a). By way of explanation, the photographic illustrations (Fig. 1 through Fig. 8B) should not be mounted (37 CFR 1.84(e)).

The rules for submitting drawings, 37 CFR 1.84 and 37 CFR 1.165, were amended effective November 29, 2000. The USPTO delayed enforcement of these changes until October 1, 2001. Complete details can be found in the May 22, 2001 *Official Gazette* (1246 OG 106-107) or on the Internet at: <http://www.uspto.gov/web/offices/com/sol/og/2001/week21/patwavr.htm>.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification

Detailed Action

must particularly point out the location and character of the area where the plant was discovered.

35 USC 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

Detailed Action

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. The disclosure is objected to under 37 CFR 1.121(e) because the Latin name of the genus and species of the claimed plant and Variety Denomination of the claimed plant should be preceded by a heading as set forth in 37 CFR 1.163(c)(4)(5) and 37 CFR 1.163(d). This information should be set forth before the "SPECIFICATION" section as set forth in 37 CFR 1.163(c).

B. Page 1, line 5, Applicants should delete "SPECIFICATION" as no specific heading is necessary and it is understood that what follows is the specification.

C. Page 1, line 8, throughout the specification, Claim, and abstract, Single quotation marks should be placed around the cultivar name "Hokuto Shiro Ichigoukin" and any other cultivar name as this is the proper way to denote a cultivar name.

Detailed Action

D. Page 1, line 12, Applicants should either italicize or underline “*Hypsizygus marumoreus*” as this is the proper way to set forth a Genus and species.

E. Page 1, lines 17 and 18, Applicants state “female” and “male”. Typically when referring to mushroom strains one strain is denoted as positive, +, and the other is denoted as negative, -. Mushroom strains do not really have a gender. Rather than stating “female” and “male”, applicants should state either “+” or “-” for the appropriate cultivar strain.

F. Page 2, lines 1-8, Applicants state a character test was started. However, this recitation does not set forth what type of asexual reproduction method was used to asexually reproduce the instant cultivar. Applicants should set forth in the specification the method used to asexually reproduce the instant plant (MPEP 1605).

G. Page 2, lines 21 and 22, Applicants state shape of stipe is “moderately thick”. “moderately thick” does not describe a shape it describes a size. Applicants should set forth an accurate shape for the instant plant’s stipe.

H. Page 2, lines 29 and 30, Applicants state the photograph shows the instant plant. However, when compared to the photographic illustration provided there is a designation of

Detailed Action

“00HM069” set forth. It is not understood what this designation represents. It is unclear if applicants have intended this to be a different testing designation or different plant. Information relative to the designation shown should be set forth in the specification. Correction and/or clarification is necessary.

I. Page 3, lines 3 and 4, Applicants state the photographs show a culture the instant plant. However, when compared to the photographic illustrations provided there is a designation of “MH025220” set forth. It is not understood what this designation represents. It is unclear if applicants have intended this to be a different testing designation or different plant. Information relative to the designation shown should be set forth in the specification. Correction and/or clarification is necessary.

J. Page 3, lines 5 and 6, Applicants state the photograph shows a parent plant. However, when compared to the photographic illustrations provided there is a Japanese designation set forth. It is not understood what this designation represents. It is unclear if this Japanese designation refers to the parent plant or a different plant. Information relative to the designation shown should be set forth in the specification. Correction and/or clarification is necessary.

Detailed Action

K. Page 3, lines 7 and 8, Applicants state the photographs show a culture of a parent plant. However, when compared to the photographic illustrations provided there are two designations "MH025220" and "MH025019" set forth. It is not understood what these designations represent. It is unclear if applicants have intended these to be different testing designations or a different plant other than the parent stated or two different plants. Information relative to the designation shown should be set forth in the specification. Correction and/or clarification is necessary.

L. Page 3, lines 9 and 10, Applicants state the photograph shows a parent plant. However, when compared to the photographic illustrations provided there is a Japanese designation along with a letter/number designation set forth. It is not understood what this designation represents. It is unclear if this Japanese and letter/number designation refers to a parent plant or a different plant. Information relative to the designation shown should be set forth in the specification. Correction and/or clarification is necessary.

M. Page 3, lines 9-15, Applicants state another parent plant variety "Miyuki M-8171". However, applicants have previously stated "Hokuto Hachigoukin" and "Hokuto Jyunigoukin" are the parental cultivars on page 1, line 16. Correction and/or clarification is necessary.

Detailed Action

N. Page 3, lines 11 and 12, Applicants state the photographs show a culture of a parent plant. However, when compared to the photographic illustrations provided there are two designations "MH025220" and "MH025066" set forth. It is not understood what these designations represent. It is unclear if applicants have intended these to be different testing designations or a different plant other than the parent stated or two different plants. Information relative to the designation shown should be set forth in the specification. Correction and/or clarification is necessary.

O. Page 3, line 17, Applicants should set forth in the specification a brief comparison between the instant plant and its parent, 'Hokuto Jyunigoukin'. Such need not be in any great detail but should at least distinguish the cultivars from each other.

P. Applicants are requested to set forth in the specification whether the parental cultivars have been patented in the United States, is currently the subject of a pending U.S. Plant Patent application, or unpatented. If patented, --(U.S. Plant Patent No.)-- should be inserted after the cultivar name. If the subject of a pending application, such should be referred to by serial number. If unpatented, --(unpatented)-- should be inserted after the appropriate cultivar name.

Detailed Action

Q. Page 4, lines 10-12, Applicants state diameter ratio of “1.59”, “1.6-1.8”, “2.1”, and “1.5-2.0”. However, ratios are usually stated as 1 to 2 or 1:2 for example. It appears the recitations set forth are actual measurements. Correction and/or clarification is necessary.

R. Page 6, Table 5, line 16, Applicants state Cap “Size”. It is uncertain whether the size set forth is for the diameter or depth of the cap. Applicants should set forth in the specification the typical and observed cap diameter and depth.

S. Applicants must set forth in the specification the recognized color dictionary which is used for setting forth color designations for the instant plant’s distinguishing characteristics (MPEP 1605).

T. Page 6, Table 5, lines 18-21, Applicants should set forth in the specification a color designation for the “White” colorations with reference to a recognized color dictionary. The recitations “White” are vague and insufficient in this regard.

U. Page 6, Table 5, lines 24 and 25, Applicants should set forth in the specification the typical and observed mottled spot quantity and diameter. The recitations “Medium” are vague and insufficient in this regard.

Detailed Action

V. Page 6, Table 5, lines 30 and 31, Applicants should set forth in the specification a color designation for the "Yellowish white" coloration with reference to a recognized color dictionary. The recitation "Yellowish white" is vague and insufficient in this regard.

W. Page 6, Table 5, lines 33 and 34, Applicants should set forth in the specification the typical and observed gill number per mushroom, gill depth and width. The recitations "Medium" are vague and insufficient in this regard.

X. Page 6, Table 5, lines 35 and 36, Applicants state "Stipe Length (mm)" but do not set forth any dimension. Applicants should set forth in the specification the typical and observed stipe length and diameter.

Y. Page 7, Table 5, line 1, Applicants state stipe shape is "Medium thick". Medium thick is not a shape but a thickness. Applicants should set forth in the specification the typical and observed stipe shape.

Z. Page 7, Table 5, line 2, Applicants should set forth in the specification a color designation for the "White" coloration with reference to a recognized color dictionary. The recitation "White" is vague and insufficient in this regard.

Detailed Action

AA. Page 7, Table 5, lines 4-6, Applicants state "Diameter under cap to maximum diameter ratio" and "Cap diameter to stipe length ratio" but do not set forth any information. Correction and/or clarification is necessary.

AB. Page 10, The Claim, The Claim should be directed to the plant as illustrated "and" described (MPEP 1605, 37 CFR 1.164). The following Claim is suggested - -A new and distinct variety of Bunashimeji mushroom plant as illustrated and described.- -.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (571) 272-0973. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached at (571) 272-0811.

The fax phone number for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

K. L. Bell



**KENT BELL
PRIMARY EXAMINER**